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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ARANI, TAGHI T	
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			2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,971	Applicant(s) HARPER, JACK	
	Examiner Taghi T. Arani	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 11, 13, 14, 16-19, 21-22 and 25 is/are rejected.
- 7) ☒ Claim(s) 7, 10, 12, 15, 20, 23, 24 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-26 have been examined.

Terminal Disclaimer

2. The Examiner acknowledges the terminal disclaimer filed on 1/20/2005 to obviate a double patenting rejection over commonly owned Application which was mailed on.

Information Disclosure Statement

3. An initialed and dated copy of Applicant's IDS form 1449, filed 7/6/2004, is attached to the instant Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claim 1-6, 8-9, 11, 13, 16-19, 21-22 and 25** are rejected under 35 U.S.C. 102(e) as being anticipated by Soltesz et al. (US 2001/0011680).

As per claim 1, Soltesz et al. teach a method and system for identifying (tracking an individual and reading biometric information pertaining to the individual from an optical card, the system comprising:

an optical card drive adapted for reading from and writing to the optical card, wherein the optical card includes biometric data of the individual [see page 1 and associated text, paragraph 0014, a second reader device for inputting biometrics

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data (image) stored on a portable storage means carried by the user, page 2, paragraph 0019-0020 , a self-service kiosk gathers image and biometric data from a registrant and a dispenser for dispensing an optical card (WORM optical card) to the registrant on which captured image and biometrics are stored];

a biometric scanner that reads the biometric information from the individual [see Fig. 2 and associated text, biometric input device 3 (i.e. a biometric scanner), page 1, paragraph 0014, biometrics reader device for obtaining biometrics data from a customer present at the kiosk, see also page 3, paragraph 00039]; and

a data processor [see page 2 and associated text, paragraph 0029 discloses a controller (data processor), see also page 3, paragraph 0033] coupled to the optical card drive and the biometric scanner [Figure 2, Biometric Input Device 3 and Optical Card Reader 2], wherein the biometric information is compared with biometric data to assist in authenticating that the individual is associated with the optical card [page 1, paragraph 0014, where a circuitry (data processor), software, or combination of circuitry and software coupled to the customer input biometrics data and the stored biometrics data for comparing the customer input biometrics with the biometrics stored on the optical card and decision and control logic module 12 decides whether to authorize a transaction based on the results of the comparison see also page 1, paragraph 003].

As per claim 3, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 1, wherein the data processor is programmed for encrypting and deciphering

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encrypted data obtained from the optical card drive [see Fig. 4, element 114 and associated text, page 3 , paragraph 0037].

As per claim 4, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 1, wherein the optical card drive, the biometric scanner, and the data processor are held in a single housing [page 2, paragraph 0029, a modular housing 1 containing a card reader device, display and controller hardware, firmware, and/or software].

As per claim 5, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 1, further comprising a barcode scanner coupled to the data processor [page 3, paragraph 0033, page 2, paragraph 0016, magnetic card reader is disclosed which the examiner interprets to corresponds to the recited barcode scanner].

As per claim 6, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 1, further comprising a communication link for sending and receiving data of the system [page 3, paragraph 0033, paragraph 0034, discloses LAN/WAN and internet connectivity].

As per claim 8, Soltesz et al. teach a system for identifying an individual and reading biometric information pertaining to the individual from an optical card (abstract), the system comprising:

an optical card drive adapted for reading an image of the individual from the optical card [page 1, paragraph 0014, a second reader device for inputting biometrics data (image) stored on a portable storage means carried by the user, page 2,

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paragraph 0019-0020, a self-service kiosk gathers image and biometric data from a registrant and a dispenser for dispensing an optical card (WORM, write one/read many times, optical card) to the registrant on which captured image and biometrics are stored];

display for displaying the image retrieved from the optical card [page 5, claim 13]; and

a data processor coupled [page 2, the disclosed controller coupled to the optical card device, see also page 5, claim 13, where the disclosed microprocessor is coupled to the display and the optical card drive] to the optical card drive and the display, wherein the image of the individual is displayed while the individual's appearance is compared to the image to assist in authenticating that the individual is associated with the optical card [page 1, paragraph 0007, Soltesz et al's optical card can be used in connection with a terminal of the type described in US patent 5,756, 978 designed to facilitate in-person cardholder verification by displaying a digital photograph of the card holder stored in encrypted form on the optical card, see also page 4, paragraph 0045, see also, page 5, claim 15].

As per claim 9, Soltesz et al. disclose the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 8, further comprising a biometric scanner[page 1, paragraph 0014, a biometric reader device (scanner) for obtaining biometrics data from a customer] that reads the biometric information from the individual, wherein:

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the optical card includes biometric data of the individual [**page 4, paragraph 0045, biometric data and/or image of the registrant are stored in encrypted form on the optical card**], and

the biometric information is compared with biometric data to assist in authenticating that the individual is associated with the optical card [**page 4, paragraph 004, the optical card is for use in identification verification and/or authentication system of the type in US pat. No. 5,756,978, see also page 1, where a circuitry compares the input biometrics data with the stored biometrics data for authorization, see also page 5, claims 13 and 15**].

As per claim 11, Soltesz et al. teach the system for identifying the individual and reading biometrics information pertaining to the individual from the optical card as recited in claim 8, wherein the optical card drive, the display, and the data processor are held in a single housing [**page 2, paragraph 0029, a modular housing 1 containing a card reader device, display and controller hardware, firmware, and/or software**].

As per claim 13, Soltesz et al. teach a system for identifying an individual and reading biometric information pertaining to the individual from an optical card, the system comprising:

a biometric scanner for obtaining biometric data from the individual [**Fig. 2, Biometric Input Device 3, Fig. 1, element 3**];

A housing comprising [**see Figure 1 and associated text, Housing 1, Figure 3 and associated text, 101**]:

an optical card drive [**Figure 1, element 2, Figure 2, card read/write device 102, see also associated texts**] adapted for reading from and writing to the optical card

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[page 2, paragraph 0020, an optical read/write unit, page 4, see also page 4, paragraph 0040, where images from the camera and the biometric input are stored (write) on the card]; and

a data processor [Figure 1, element 7, Figure 3, controller 107, page 2, paragraph 0029] coupled with the optical card drive and the biometric scanner, wherein the data processor assists in comparing data from said optical card and the biometric data [page 1, paragraph 0014] and delivers data to the optical card drive for writing on the optical card, page 4, paragraph 0040, where controller delivers the image from the camera to the optical card through optical card device]; and

a video output for displaying an image corresponding the individual, wherein the image is read from the optical card [Figure 1, display 6, page 1, paragraph 0007, Soltesz et al's optical card can be used in connection with a terminal of the type described in US patent 5,756, 978 designed to facilitate in-person cardholder verification by displaying a digital photograph of the card holder stored in encrypted form on the optical card].

As per claim 16, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 13, wherein the optical card includes software for interpreting information stored on the optical card [page 3, paragraph 0036].

As per claim 17, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 13, wherein the housing further comprises a printer that is coupled to the data

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processor [see **Figure 1 and associated text, a printer 4, see also page 2, paragraph 0016**].

As per claim 18, Soltesz et al. teach the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 13, wherein the biometric scanner comprises at least one of a fingerprint reader [see **Figure 1 and associated text, biometric input device 3**], an iris reader, hand geometry reader, voice recognition device, face recognition device, and a DNA recognition device [page 1, paragraph 0008].

As per claim 19, Soltesz et al. the system for identifying the individual and reading biometric information pertaining to the individual from the optical card as recited in claim 13, wherein the optical card is disk-shaped [Soltesz et al. 's biometric information is stored on **WORM type portable storage device carried by a user, page 3, paragraph 0038 (i.e. a disk)**]. The Examiner asserts that limitations relating to size, weight and shape are not sufficient to patentably distinguish over the prior art (see In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955, In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976))

As per claim 21, Soltesz et al. teach a method for tracking an individual and information about the individual, the method comprising:

assigning an optical card to the individual [page 2, paragraph 0019-0020, a self-service kiosk gathers image and biometric data from a registrant and a dispenser for dispensing an optical card (WORM optical card) to the registrant on which captured image and biometrics are stored];

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reading first biometric information from the optical card [**Fig. 2 and associated text, optical card reader 2 reads biometrics data stored on the optical card (page 3, paragraph 031), page 1, paragraph 0014, a second reader device for inputting biometrics data stored on a portable storage means carried by the user];**

gathering second biometric information from the individual [**Fig. 2 and associated text, biometric input device 3 (i.e. a biometric scanner), page 1, paragraph 0014, biometrics reader device for obtaining biometrics data from a customer present at the kiosk, see also page 3, paragraph 00039];**

comparing first biometric information and the second biometric information [**Figure 2, Comparator 11, page 1, paragraph 0014, a circuitry, software, or combination of circuitry and software for comparing the customer input biometrics data with the stored biometrics data], wherein the reading, gathering and comparing steps are performed with a system that includes a optical card drive [Figure 1, card reader device 1], a biometric scanner [Figure 1, biometric input device 3, page 3, paragraph 0031] and a data processor [controller 11 with hardware, firmware, and /or software 7, see page 2, paragraph 0029] ;**

and

authenticating an identity of the individual based upon, at least, the comparing step [**page 2, paragraph 0029, where controller 11 compares the inputs from the optical card and the biometric input device and decision and control logic module 12 decides whether to authorize a transaction based on the results of the comparison].**

As per claims 2 and 22, Soltesz et al. teach the system/method as recited in claims 1 and 21 respectively, further comprising steps of:

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providing a display for displaying data from the data processor [see **Figure 1 and associated text, display 6**];

reading an image from the optical card [col. 1, paragraph 0007, where the **disclosed self-service kiosk is capable of collecting an image of the user and/or biometrics data**];

displaying the image on the display, whereby an attendant can compare the image with the individual to authenticate that the optical card is associated with the individual [page 1, paragraph 0007, **Soltesz et al's optical card can be used in connection with a terminal of the type described in US patent 5,756, 978 designed to facilitate in-person cardholder verification by displaying a digital photograph of the card holder stored in encrypted form on the optical card**].

As per claim 25, Soltesz et al. teach the system and method of claim 21, further comprising a step of encrypting information that is written on the optical card [page 3, paragraph 0037].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soltesz et al. as applied to claim 13 above and further in view of Soltesz (USP 5,027,401)

It is noted that Soltesz et al. (USP 2001/0011680) do not disclose in the optical

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card stores a prescription or other medical therapy “. However, the use of optical card to store other types of sensitive information including medical type data is disclosed by Soltesz in US Patent 5, 027,401 (col. 6, line 39).

It would have been obvious to one ordinary skill in the art at the time the invention was made to store any type of information including sensitive data in the optical card. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)). The prior art is replete with references disclosing optical cards used to store information (sensitive, encrypted or otherwise normal data).

Allowable Subject Matter

6. **Claims 7, 10, 12, 15, 20, 23-24 and 26** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Prior arts made of record, not relied upon:

US 5,815,252 is directed to a system for verifying that a card possessor is the authorized card owner compares scanned fingerprint data with fingerprint data encoded on an optical card. More than one of the person's fingerprints are encoded on the card, and the process of identification of the card possessor involves the random selection of separate fingerprints for scanning and comparison against the encoded fingerprints. A card reader/writer reads fingerprint characteristic information from an optical card

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inserted therein and a processing unit, connected to a fingerprint scanner and card reader/writer extracts from the scanned fingerprint certain well known indicators, and matches the recorded fingerprint characteristic data with the scanned fingerprint characteristics to establish identity therebetween.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Examiner

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4/16/05